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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/902,048 | 07/10/2001 | Michael Lee Vatter | 8163 | 7755 |

27752 7590 12/18/2002

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

WILLIS, MICHAEL A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1617

DATE MAILED: 12/18/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,048

Applicant(s)

VATTER, MICHAEL LEE

Examiner

Michael A. Willis

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8. 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 19 September 2002 is entered. Claims 1, 7, and 10-12 are amended. Claims 1-12 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Terminal Disclaimer

The provisional rejection of claim 12 under obviousness-type double patenting is withdrawn in view of entry of a Terminal Disclaimer submitted 19 September 2002.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 16 July 2002 and 26 August 2002 are considered. See attached copies with initials and signature.

Response to Arguments

Claims 1-12 are rejected under 35 USC 103(a) as being unpatentable over Schulz et al (US Pat. 5,654,362) in view of Dreschler et al (US Pat. 6,071,503) for reasons as stated previously.

Applicant argues that Schulz, while teaching methods of makeup removal, fails to specifically teach transfer-resistant makeup removal. With respect to claim 12, applicant argues that Schulz also lacks a layered substrate. Applicant further argues that

Art Unit: 1617

Dreschler, while teaching removal of transfer-resistant makeup, fails to use the exact compositions as taught by Schulz.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant rejection, the deficiencies of Schulz are remedied by Dreschler, and vice versa. Specifically, Dreschler clearly teaches the use of dimethicone-based cosmetic remover in combination with a tissue to remove transfer-resistant makeup (see col. 15, lines 14-18). Schulz teaches the use of silicone elastomers in combination with dimethicone-based fluids, (see col. 4, lines 28-55), for compositions such as color cosmetic removers (see col. 7, lines 55-56). Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, Schulz's teachings of silicone-based cosmetic removers with silicone elastomers would have suggested the use of such cosmetic removers for the removal of transfer-resistant makeup where the prior art of Dreschler teaches such a use for silicone-based cosmetic removers.

Applicant argues that “obvious to try” is not a valid test of patentability, and that the examiner cannot pick and choose among references to recreate the claimed invention based on hindsight reasoning. Rather, applicant argues that the examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for the combination comes from the teaching of Schulz that the use of silicone elastomers adds a lubricious quality and improves the properties of the composition with respect to leveling and spreading (see col. 7, lines 34-65).

Finally, applicant argues that neither Schulz nor Dreschler include a particle size limitation of 10-200 microns for the elastomer. Dreschler is irrelevant with respect to particle size of the elastomer. While Schulz does not specifically state a limitation of 10-200 microns diameter for the elastomer, Schulz does teach the formulation of the elastomer as a powder (see col. 2, lines 11-21; Example III; col. 7, lines 34-60; and claim 12). A powder is “any solid, dry material of extremely small particle size ranging down to colloidal dimensions” where colloidal dimensions involve particle sizes between

Art Unit: 1617

1 and 100 nm (see Hawley's Condensed Chemical Dictionary, 13th edition, pages 924 and 288). Therefore, the claimed range of 10-200 microns falls within the particle size range for a powder as taught by Schulz. It is noted that Hawley's Condensed Chemical Dictionary is cited merely to define powder rather than as a basis for the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone

Art Unit: 1617

numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
December 12, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

12/13/02